## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of claims 67-75, 77, 79-84, 88-90, 93, 94, 96, 99-102, and 118-130 in the reply filed on 11/09/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-66, 89-92, 94-100, are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 09, 2007. Applicant stated withdrawn claims 93, 94, 96, 99, 100, 101, and 102 should be included with Group II as being directed to a method of using a patch. Applicant also elected Species C of SET I for species drawn to applying with an electrode formed in a decorative shape and using a conductive layer. Claims 94, 96, and 99-100 are drawn to the non-elected species of a stencil and transferable sheet. Therefore, claims 94, 96, and 99-100 remain withdrawn. Claims 93 and 101-102 are included for prosecution. Additionally, claims 75, 77, 79, 118, and 123 are withdrawn as being drawn to the nonelected species of applying with a stencil as embodied by the decorative template and for the purposes of prosecution claim 67 part f will be considered to not include the decorative template. Further, applicant elected Species X of SET V drawn to applying a color formulation. Claims 89 and 90 are being withdrawn as they are drawn to the non-elected species of removing a color formulation.

### *Specification*

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. The hyperlink is found on page 17 [0056].

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 67-68, 70-72, 74, 80, 93, 102 and 130 are rejected under 35 U.S.C. 102(e) as being anticipated by Henley et al. (U.S. Patent 6,447,410).

With regard to claim 67, Henley et al. teaches **an iontophoretic patch for applying a body decoration to a subject comprising** (It is taught that one type of electrokinetic delivery is iontophoresis Col. 1 lines 15-16; the disclosed device is an electorkinetic device for delivering or removing a substance including inks and pigments for tattoos Col. 1 lines 56, 61-63; Figure 1 device 10, Figure 12 pad device is taken to be patch adhered to skin Col. 24 lines 19-25)**: (a) a substrate base layer** (Figure 12 substrate 110, Col. 23 line 49)**; (b) a first electrode attached to said substrate base layer, wherein said first electrode is an active electrode** (Figure 12 first/active electrode 112 is attached to the substrate 110 via pad 111, Col. 23 lines 54-56)**; (c) a**

**second electrode attached to said substrate base layer** (Figure 12 ground electrode 118 is attached to substrate 110)**; (d) a power supply attached to said first and second electrodes for supplying current to said electrodes** (Figure 12 battery 116, taken to be the power supply, is attached to electrodes 112 and 118, Col. 23 lines 56-60)**; (e) a conductive color formulation comprising at least one ink suitable for facilitating a body decoration on said first electrode** (Figure 12 Pad 111 contains the electrically conductive medicament (Col. 9 lines 25-26), which can be ink or pigment it is disposed on the first electrode 112)**; and (f) optionally an insulating, flexible decorative template comprising a cut-out in the shape of the body decoration** (For purposes of examination the device is considered not to include the decorative template, however it is noted that in Col. 5 lines 18-20 it is disclosed that a decal or template may be used with the device, and that insulating devices may be disposed between the pad and conductive material (Col. 20 lines 41-42)**; wherein said patch promotes penetration of said color formulation into said body area to form said body decoration** (device transports substance through skin Col. 1 lines 60-64). Henley et al. dose not specifically disclose **the durability of the body decoration is controlled according to at least one of: the color of the color formulation, the type of dye in the color formulation, and the dye concentration in the color formulation and/or a decorative template.** However, since Henley et al. is using an ink or pigment, it necessarily follows that the resulting durability of the subsequent body decoration will ultimately, indirectly, be affected by the choice of ink or pigment and the characteristics inherent to the ink or pigment chosen.

With regards to claims 68 and 72, Henley et al. teaches that an applicator portion overlying the electrode may contain an electrically conductive hydrogel and when pressed against the skin electrical contact is facilitated (Col. 8 lines 5-10).

With regard to claim 70, Henley et al. teaches the pad should be thin and somewhat flexible (Col. 9 lines 31-33).

With regard to claim 71 it would have been obvious to one of ordinary skill in the art to print on the patch an identifier or other appliqué to illustrate the body decoration that will be imprinted.

With regard to claim 74, Henley et al. teaches the medicament being used can be electrically conductive (Col. 9 lines 25-26) and an ink or pigment (Col. 1 line 62).

With regard to claim 80, Henley et al. teaches the device being used with inks or pigments which can be used for both temporary and permanent tattoos (Col. 5 lines 15-16).

With regard to claims 93 and 102, Henley et al. teaches providing the device as discussed above with reference to claim 67, contacting this device to the treatment site, the means for applying the color formulation would be the pad containing the substance, and it is electrokinetically driven into the skin (Col. 1 lines 62-64 - color formulation, Col. 24 lines 9-20 - use of device). Further regarding claim 102, the electric current is applied once the circuit is complete and all parts are in contact (Col. 8 lines 44-46).

With regard to claim 130, the device in Henley et al. can be taken to be configured as part of a kit because the device can already include the ink or medicament needed to be used with the device (Col. 6 lines 47-48).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 73 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) as applied to claim 67 above and further in view of Inoue et al. (U.S. Patent 6,597,947).

With regard to claims 73 and 101, Henley et al. does not teach the active electrode or conductive layer/color formulation in the shape of a body decoration. Inoue et al. teaches an iontophoretic device in which the active electrode structure consists of an electrode 101a directly inline with a conductive 102a layer and active layer 103a (in Figure 1, Col. 7 line 59-64, Col. 8 lines 7-8) All layers are in the same shape, which is taken to encompass the claimed shape of the body decoration. Since both the electrode and the patch comprise the same shape, it would necessarily follow that the body decoration would take that shape. It would have been obvious to one of ordinary skill in the art to substitute the electrode structure of Inoue et al. in that of Henley et al. as they are art recognized equivalents and the structure of Inoue et al. can be used to yield the predictable result of delivering a medicament, in the case of Henley et al. which is a pigment, to the body.

8. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) as applied to claim 67 above in paragraph 5, and further in view of Nitzan (U.S. Patent 5,652,043).

With regard to claim 69, Henley teaches a battery power source, a battery is an electrochemical cell, which is a film sheet stacked battery (Col. 11 lines 54-56). Heneley et al. does not teach that this film sheet is thin and flexible. However, Nitzan teaches a flexible, thin layer open electrochemical cell for use in miniaturized portable electronics (Col. 2 lines 12-14). It would have been obvious to a person of ordinary skill in the art to use a thin, flexible cell in the battery of Henley et al. because it would allow the device to better conform to the skin area which the device is contacting.

9. Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) as applied to claim 67 above in paragraph 5, and further in view of Muratore-Pallatino et al. (US 2002/0110672).

With regard to claim 81 Henley et al. teaches the device being used with inks or pigments which can be used for both temporary and permanent tattoos (Col. 5 lines 15-16). Henley et al. does not teach the temporary tattoo capability being used for make-up, though the device of Henley et al. is not limited to a specific part of the body or specific pigments; and is therefore capable of applying semi-permanent make-up, which is effectively a temporary tattoo. However, Muratore-Pallatino et al. teaches a temporary tattoo for the cover-up of veins, blemishes, age marks, scars, and other skin imperfections (Pg. 2 [0041]). It would have been obvious to a

person of ordinary skill in the art to use the temporary tattoo in Henley et al. as semi-permanent make-up as it would be effective in covering up blemishes etc.

10. Claims 82-84 rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) in view of Inoue et al. (U.S. Patent 6,597,947).

With regard to claim 82, Henley et al. teaches **an iontophoretic patch for applying a body decoration to a subject comprising** (It is taught that one type of electrokinetic delivery is iontophoresis Col. 1 lines 15-16; the disclosed device is an electorkinetic device for delivering or removing a substance including inks and pigments for tattoos Col. 1 lines 56, 61-63; Figure 1 device 10, Figure 12 pad device is taken to be patch adhered to skin Col. 24 lines 19-25) comprising: **a first electrode, wherein the first electrode is an active electrode** (Figure 12 first/active electrode 112 Col. 23 line 54); **a second electrode** ( Figure 12 ground electrode 118); **a power supply attached to the first and second electrodes for supplying current to the first and second electrodes** (Figure 12 battery 116, taken to be the power supply, is attached to electrodes 112 and 118, Col. 23 lines 56-60); **and a color formulation on the first electrode** (Figure 12 Pad 111 contains the electrically conductive medicament (Col. 9 lines 25-26), which can be ink or pigment it is disposed on the first electrode 112). Henley et al. does not teach **wherein the active electrode is in the shape of the body decoration, and the patch promotes penetration of the color formulation into a body area of the subject to form the body decoration**. However, Inoue et al. teaches an iontophoretic device in which the active electrode structure consists of an electrode 101a directly inline with a conductive 102a layer and active layer 103a (in Figure 1, Col. 7 line 59-64, Col. 8 lines 7-8) All layers are in the same shape,

which is taken to encompass the claimed shape of the body decoration. Since both the electrode and the patch comprise the same shape, it would necessarily follow that the body decoration would take that shape. It would have been obvious to one of ordinary skill in the art to substitute the electrode structure of Inoue et al. in that of Henley et al. as they are art recognized equivalents and the structure of Inoue et al. can be used to yield the predictable result of delivering a medicament, in the case of Henley et al. which is a pigment, to the body.

With regard to claim 83, Figure 12 shows substrate 110.

With regard to claim 84, the medicament in the pad on the first electrode can be electrically conductive and would provide a conductive interface between the electrode and skin (Figure 12 Pad 111 contains the electrically conductive medicament (Col. 9 lines 25-26), which can be ink or pigment it is disposed on the first electrode 112).

11. Claims 67-68, 70-72, 74, 80, 93, 102 and 130 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) in view of Yuzhakov et al. (U.S. Patent 6,565,532).

It is noted that claim 67 is anticipated by Henley et al. in paragraph 5 however, the following is a back-up rejection in the event that the argument for inherency is found to be non-persuasive. With regard to claim 67, Henley et al. teaches **an iontophoretic patch for applying a body decoration to a subject comprising** (It is taught that one type of electrokinetic delivery is iontophoresis Col. 1 lines 15-16; the disclosed device is an electorkinetic device for delivering or removing a substance including inks and pigments for tattoos Col. 1 lines 56, 61-63; Figure 1

device 10, Figure 12 pad device is taken to be patch adhered to skin Col. 24 lines 19-25)**: (a) a substrate base layer** (Figure 12 substrate 110, Col. 23 line 49)**; (b) a first electrode attached to said substrate base layer, wherein said first electrode is an active electrode** (Figure 12 first/active electrode 112 is attached to the substrate 110 via pad 111, Col. 23 lines 54-56)**; (c) a second electrode attached to said substrate base layer** ( Figure 12 ground electrode 118 is attached to substrate 110)**; (d) a power supply attached to said first and second electrodes for supplying current to said electrodes** (Figure 12 battery 116, taken to be the power supply, is attached to electrodes 112 and 118, Col. 23 lines 56-60)**; (e) a conductive color formulation comprising at least one ink suitable for facilitating a body decoration on said first electrode** (Figure 12 Pad 111 contains the electrically conductive medicament (Col. 9 lines 25-26), which can be ink or pigment it is disposed on the first electrode 112)**; and (f) optionally an insulating, flexible decorative template comprising a cut-out in the shape of the body decoration** (For purposes of examination the device is considered not to include the decorative template, however it is noted that in Col. 5 lines 18-20 it is disclosed that a decal or template may be used with the device, and that insulating devices may be disposed between the pad and conductive material (Col. 20 lines 41-42)**; wherein said patch promotes penetration of said color formulation into said body area to form said body decoration** (device transports substance through skin Col. 1 lines 60-64). Henley et al. dose not teach **and wherein durability of the body decoration is controlled according to at least one of: the color of the color formulation, the type of dye in the color formulation, and the dye concentration in the color formulation and/or a decorative template.** However, Yuzhakov et al. teaches that the size of the particles that make up the ink or dye being used can determine how far into the skin the substance will

penetrate (Col. 42 lines 3-10, 58-63). Therefore, it would have been obvious to a person of ordinary skill in the art to control the durability of penetration due to the color of the color formulation because the depth of penetration is controlled by the particle size, thereby the color itself, and the further into the skin the substance is penetrated it will be more durable or less durable.

Claims 68, 70-72, 74, 80, 93, 102, and 130 are rejected using the reasoning as applied in paragraph 5 above.

12. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) and Yuzhakov et al. (U.S. Patent 6,565,532) as applied to claim 67 above, and further in view of Nitzan (U.S. Patent 5,652,043).

With regard to claim 69, Henley teaches a battery power source, a battery is an electrochemical cell, which is a film sheet stacked battery (Col. 11 lines 54-56). Heneley et al. does not teach that this film sheet is thin and flexible. However, Nitzan teaches a flexible, thin layer open electrochemical cell for use in miniaturized portable electronics (Col. 2 lines 12-14). It would have been obvious to a person of ordinary skill in the art to use a thin, flexible cell in the battery of Henley et al. because it would allow the device to better conform to the skin area which the device is contacting.

13. Claims 73 and 101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) and Yuzhakov et al. (U.S. Patent 6,565,532) as applied to claim 67 above and further in view of Inoue et al. (U.S. Patent 6,597,947).

With regard to claims 73 and 101, Henley et al. does not teach the active electrode or conductive layer/color formulation in the shape of a body decoration. Inoue et al. teaches an iontophoretic device in which the active electrode structure consists of an electrode 101a directly inline with a conductive 102a layer and active layer 103a (in Figure 1, Col. 7 line 59-64, Col. 8 lines 7-8) All layers are in the same shape, which is taken to encompass the claimed shape of the body decoration. Since both the electrode and the patch comprise the same shape, it would necessarily follow that the body decoration would take that shape. It would have been obvious to one of ordinary skill in the art to substitute the electrode structure of Inoue et al. in that of Henley et al. as they are art recognized equivalents and the structure of Inoue et al. can be used to yield the predictable result of delivering a medicament, in the case of Henley et al. which is a pigment, to the body.

14. Claim 81 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) and Yuzhakov et al. (U.S. Patent 6,565,532) as applied to claim 67 above, and further in view of Muratore-Pallatino et al. (US 2002/0110672).

With regard to claim 81 Henley et al. teaches the device being used with inks or pigments which can be used for both temporary and permanent tattoos (Col. 5 lines 15-16). Henley et al. does not teach the temporary tattoo capability being used for make-up, though the device of Henley et al. is not limited to a specific part of the body or specific pigments; and is therefore capable of applying semi-permanent make-up, which is effectively a temporary tattoo. However, Muratore-Pallatino et al. teaches a temporary tattoo for the cover-up of veins, blemishes, age marks, scars, and other skin imperfections (Pg. 2 [0041]). It would have been obvious to a

person of ordinary skill in the art to use the temporary tattoo in Henley et al. as semi-permanent make-up as it would be effective in covering up blemishes etc.

15. Claims 86, 88, 119-122, 124-129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) in view of Muratore-Pallatino et al. (US 2002/0110672).

With regard to claim 86, Henley et al. teaches **an iontophoretic patch for applying a body decoration to a body area of a subject and for treating said body area, comprising: an electrically powered patch** (Figure 12 pad 111 adheres to skin and is powered by battery 116, Col. 23 lines 53-56). Henley et al. does not specifically teach **a formulation comprising an active ingredient for treating a condition and at least one color suitable for facilitating a body decoration, wherein said patch provides current and promotes penetration of the formulation into said body area to facilitate simultaneously a body decoration and treatment of a condition of the body area.** However, the device is disclosed to have applicators with different medicaments as required for various treatments (Col. 8 lines 56-57), further multiple substances can be encapsulated within the pad (Col. 9 lines 6-8). Additionally, medicaments to be used in the device include ink or pigment for body decoration and (Col. 1 line 62) many other medicaments for treatment throughout the patent. Muratore-Pallatino et al. teaches a temporary tattoo for both concealing and medicating a skin condition (Pg. 2 [0041]). It would have been obvious to one of ordinary skill in the art to use a combination of two listed medicaments to be encapsulated in the pad, in this case a color and a treatment medicine,

because the coloration would conceal the condition and the medicament would treat it simultaneously.

With regard to claim 88, Henley et al. teaches acne treatments (Col. 5 line 24).

With regard to claim 119, Henley et al. teaches using an ink or pigment for tattooing (Col. 1 line 62).

With regard to claim 120 the device in Henley can be taken to be configured as part of a kit because the device can already include the ink or medicament needed to be used with the device (Col. 6 lines 47-48).

With regard to claim 121, Henley teaches a first electrode; wherein said first electrode is an active electrode (Figure 12 first/active electrode 112 Col. 23 line 54); a second electrode separated from the first electrode ( Figure 12 ground electrode 118 is separate from first electrode 112); a power supply supported on a base member (Figure 12 battery 116, taken to be the power supply, is attached to electrodes 112 and 118 which are attached to substrate base 110, Col. 23 lines 56-60).

With regard to claim 124 Henley et al. teaches temporary tattoos (Col. 5 lines 15-16).

With regard to claim 126 Henley et al. teaches applying a substance to skin, nails and teeth (application to skin Col. 1 lines 59-60, nails Col. 29 line 32, teeth Col. 5 lines 40-43 - dentin is a component in teeth).

With regard to claims 125 and 127-128 Henley et al. does not teach the body decoration comprising make-up, covering a skin condition, or using a color the same as skin color. However, Muratore-Pallatino et al. teaches a temporary tattoo for both concealing and medicating a skin condition to provide cover-up to the skin that would have the appearance of

human skin (Pg. 2 [0041]). Therefore it would have been obvious to a person or ordinary skill in the art to use the ink and pigment in Henley et al. (Col. 1 line 62) as a make-up or to cover a skin condition and when doing so use a color that is skin colored because Muratore-Pallatino et al. teaches temporary tattoos being used in this manner and the device in Henley et al. is capable of doing so and it would provide the predictable result of covering blemishes in the skin etc.

16. Claims 122 and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley et al. (U.S. Patent 6,447,410) and Muratore-Pallatino et al. (US 2002/0110672) as applied to claims 121 and 86 above, and further in view of Inoue et al. (U.S. Patent 6,597,947).

With regard to claims 122 and 129, Henley et al. does not teach the active electrode or conductive layer/color formulation in the shape of a body decoration. Inoue et al. teaches an iontophoretic device in which the active electrode structure consists of an electrode 101a directly inline with a conductive 102a layer and active layer 103a (in Figure 1, Col. 7 line 59-64, Col. 8 lines 7-8) All layers are in the same shape, which is taken to encompass the claimed shape of the body decoration. It would have been obvious to one of ordinary skill in the art to substitute the electrode structure of Inoue et al. in that of Henley et al. as they are art recognized equivalents and the structure of Inoue et al. can be used to yield the predictable result of delivering a medicament, in the case of Henley et al. which is a pigment, to the body.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMILY WACHTEL whose telephone number is (571)270-3648.

The examiner can normally be reached on Monday through Thursday 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Yao can be reached on (571) 272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. W./
Examiner, Art Unit 4111

/Sam Chuan C. Yao/
Supervisory Patent Examiner, Art Unit 4111